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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,282	12/17/1999	DENNIS RUBEN	42543.3	9978

28765 7590 02/05/2004

WINSTON & STRAWN  
PATENT DEPARTMENT  
1400 L STREET, N.W.  
WASHINGTON, DC 20005-3502

EXAMINER

GARLAND, STEVEN R

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 02/05/2004

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Dr.

## Office Action Summary

**Application No.**

09/466,282

**Applicant(s)**

RUBEN ET AL.

**Examiner**

Steven R Garland

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003 and 08 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,6-9,11,18 and 21-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-9,11,18,21-23,25,26,32-34 is/are rejected.
- 7) ☒ Claim(s) 24,27-31 and 35-38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/10/2003 has been entered.

2. Applicant's arguments, see page 7, lines 6-9, filed 11/10/2003, with respect to the rejection under 35 U.S.C. 112, 2<sup>nd</sup> paragraph have been fully considered and are persuasive. The rejection of claims 21-23, 25, and 26 has been withdrawn.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 6-9,11,18,21-23,25, 26, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegel 4,732,411 in view of Kutsuma 5,905,652 and Foote et al. 5,642,906.

Siegel teaches using a label having a miniature photograph of the patient on a prescription container. Siegel teaches that the picture is taken of the patient and then stored in computer memory so that it can be produced on demand. Siegel provides a teaching that it is desirable in a nursing home environment that the patient receives the correct medication, in col. 1, lines 15-61. Siegel however does not specifically identify the type of device used to take the patient picture. See the abstract; figure 1; col. 2, lines 1-64; col. 3, lines 1-66; and claim 1.

Siegel however does not specifically state that two computers can be used; that databases are used, that a laser printer is used, or that a digital camera is used.

Kutsuma teaches the use of a digital camera; inputting a picture into a computer; transmitting a picture from one computer to another computer and combining the picture with other prescription information and printing the combined information. Kutsuma also teaches storing the picture and prescription information in separate memories which form databases. Kutsuma also teaches that if the required picture is not stored in memory taking a picture and storing the picture in memory. See fig. 6; col. 4, lines 26-48; col. 6, lines 13-27.

It would have been obvious to one of ordinary skill in the art to modify Siegel in view of Kutsuma to use a printer, digital camera, databases, and multiple computers as taught by Kutsuma to produce a label with a patient picture and other information such

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as medication pictures and prescription information. This would allow printing a label at various locations in case a printer fails or sending the information to different pharmacies and insure the correct patient receives the correct medications. This would also allow a digital camera to obtain various types of information such as a patient picture and medication pictures and speed picture processing by not requiring the use of a scanner to scan in a photograph.

Siegel and Kutsuma however do not teach the use of an inventory database or laser printer.

Foote et al. teaches the use of a laser printer and of plural databases including an inventory database during formation of a label. Foote also teaches including the name and address of the pharmacy on the label. See the abstract; figures; col. 2, lines 1-12; col. 2, line 53 to col. 3, line 25. Note figure 4.

It would have been obvious to one of ordinary skill in the art to modify Siegel and Kutsuma in view of Foote and use plural databases including an inventory database to form the label and use a laser printer to print the label. This would allow all the desired and needed information to be easily gathered and printed on the label.

Further it would have been obvious to one of ordinary skill in the art to update the inventory database of Siegel, Kutsuma, and Foote as the inventory changes so as to have an accurate record of the inventory and allow ease in determining when to reorder replacement quantities and to track controlled substances.

Further it would have been obvious to one of ordinary skill in the art to use the generated labeled containers with a patient picture in a nursing home to verify that the patient receives the correct medications.

In response to applicant's arguments, Siegel provides the motivation for use of a patient picture to insure that the patient receives the correct medication and also provides the teaching for storing a patient picture in memory for ease in retrieval and Siegel further teaches a label including both a patient picture combined with other information. See col. 2, lines 20-24 and 54-64. Further the examiner has provided various motivations for making the combination of references to give an improved patient prescription system.

In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

6. Claims 1, 6-9, 11, 18, 21-23, 25, 26 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cloninger WO99/17218 in view of Kutsuma 5,905,652 and Foote et al. 5,642,906.

Cloninger discloses use of a digital camera to take a picture of the patient; electronically digitizing, storing, and accessing the image of the patient; tracking order, issue, and administration of medication for billing purposes; transmitting prescription and picture information from a system computer to the pharmacy computer where the

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prescription is filled and a label is generated with a patient picture. Cloninger also teaches using a label with a picture on it in an in-patient healthcare environment. See the abstract; pages 1,3,4,6,9,11-16,18-20 and the figures.

Cloninger however does not teach the use of separate databases or the use of laser printer to implement the printer.

Kutsuma teaches the use of a digital camera; inputting a picture into a computer; transmitting a picture from one computer to another computer and combining the picture with other prescription information and printing the combined information. Kutsuma also teaches storing the picture and prescription information in separate memories which form databases. Kutsuma also teaches that if the required picture is not stored in memory taking a picture and storing the picture in memory. See fig. 6; col. 4, lines 26-48; col. 6, lines 13-27.

It would have been obvious to one of ordinary skill in the art to modify Cloninger in view of Kutsuma and use separate databases for the various types of information so that it could be easily modified and retrieved.

Cloninger and Kutsuma however do not teach the use of an inventory database or laser printer.

Foote et al. teaches the use of a laser printer and of plural databases including an inventory database during formation of a label. Foote also teaches including the name and address of the pharmacy on the label. See the abstract; figures; col. 2, lines 1-12; col. 2, line 53 to col. 3, line 25. Note figure 4.

It would have been obvious to one of ordinary skill in the art to modify Cloninger and Kutsuma in view of Foote and use plural databases including an inventory database to form the label and use a laser printer to print the label. This would allow all the desired and needed information to be easily gathered and printed on the label.

Further it would have been obvious to one of ordinary skill in the art to update the inventory database of Cloninger, Kutsuma, and Foote as the inventory changes so as to have an accurate record of the inventory and allow ease in determining when to reorder replacement quantities and to track controlled substances.

In addition it would have been obvious to one of ordinary skill in the art to use the combination of Cloninger, Kutsuma, and Foote in an in-patient healthcare facility such as a nursing home in view of Cloninger teaching to insure that the patients receive the correct medications.

In response to applicant's arguments, Cloninger provides the motivation for use of a patient picture to insure that the patient receives the correct medication and prevent errors. Cloninger also teaches the use of a digital camera to obtain a patient picture and supplying the picture to a computer and memory on page 14, lines 6-10. Also the examiner has provided various motivations for making the combination of references to give an improved patient prescription system.

7. Claims 24, 27-31, and 35-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

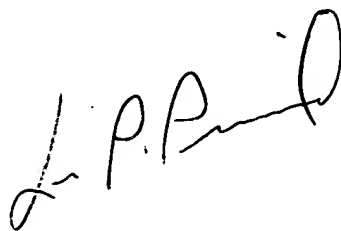


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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R Garland whose telephone number is 703-305-9759. The examiner can normally be reached on Monday-Thursday from 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on 703-308-0538. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



*SRG*  
Steven R Garland  
Examiner  
Art Unit 2125

**LEO PICARD**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**